THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROSHI NOJIRI, SACHIO NAITO,
HIDEHISA TAKAHASHI, MASARU FUJIKI, and MUJO KIM

Appeal No. 95-3320
Application 07/974,510[1]

HEARING: December 8, 1998

Before WINTERS, WILLIAM F. SMITH, and GRON, Administrative Patent Judges.

GRON, Administrative Patent Judge.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

This is an appeal under 35 U.S.C. § 134 from an

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[1] Application for patent filed November 12, 1992.

examiner's rejections of Claims 1-3 and 5-18, all claims pending in this application.

Introduction

Claims 1-3 and 5-18 stand finally rejected under 35 U.S.C. § 103 as being unpatentable in view of the combined teachings of Widder, U.S. Patent 3,987,161, issued October 19, 1976, and Tizard, Veterinary Immunology, W.B. Saunders Co., Philadelphia, PA, p. 168 (1977). Claim 1 is representative of the subject matter claimed and reads:

> 1. A hair care product comprising a yolk antibody which has been obtained from an egg of a domestic fowl immunized using human hair as an antigen.

Discussion

Widder describes a hair care product comprising an antibody-containing serum which has been obtained from the blood of "[a]ny animal which is capable of forming antibodies in the blood" (Widder, col. 2, l. 8-9), typically rabbits and horses (Widder, col. 2, l. 11-12), when its body is injected with an aqueous suspension of mammalian, preferably human hair particles (Widder, col. 1, l. 22-42).

Tizard teaches at page 168, second full paragraph:

> Chicks may acquire antibody from the hen via the yolk. Antibodies are readily transmitted to the yolk while still in the ovary, and in the fluid phase of the yolk are found at levels equal to that in hen serum. . . . Because of this passively acquired antibody, the newly hatched chick is resistant to successful vaccination in the same way that young mammals are.

In re Dow Chem. Co., 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988), instructs at 473, 5 USPQ2d at 1531:

> The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. . . . Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure.

The above criterion for determination of obviousness, as it applies to the facts in this case, raises the following questions:

(1) Would Widder's teaching have suggested to one having ordinary skill in the art to use antibody-containing serum which has been obtained from the blood of a domestic fowl immunized using human hair as an antigen in hair care products?

(2) Would Widder's teaching reasonably have led one

having ordinary skill in the art to expect that antibody-containing serum which has been obtained from the blood of a domestic fowl immunized using human hair as an antigen would be useful in hair care products?

(3) Would the combined prior art teachings have suggested to one having ordinary skill in the art to use yolk antibody which has been obtained from an egg of a domestic fowl immunized using human hair as an antigen in hair care products?

(4) Would the combined prior art teachings reasonably have led one having ordinary skill in the art to expect that yolk antibody which has been obtained from an egg of a domestic fowl immunized using human hair as an antigen would be useful in hair care products?

To answer these questions and determine the patentability of the claimed subject matter under 35 U.S.C. § 103 in light of the applied prior art, we have considered the evidence and arguments of record, including the specification and claims, appellants' Appeal and Reply Briefs, the Examiner's Answer, the applied prior art, the Declaration Under 37 CFR 1.132 by Hiroshi Nojiri, filed February 17, 1994, the attachments

thereto, inter alia. We note especially the following acknowledgment in appellants' specification (Specification, p. 3, l. 4-8):

> . . . [I]t is well known that an antiserum obtained from a mammal has complement-activating effects so that it tends to stimulate neutrophils to cause local inflammation. It is therefore preferred not to use a mammal antiserum in hair care products.

Accordingly, by applicants' admission, persons having ordinary skill in the art would have preferred to use and would have had adequate incentive to try to use serum antibody which is obtained from the blood of a non-mammalian animal immunized using human hair as an antigen as the antibody-containing serum Widder suggests for use in hair care products. Would persons having ordinary skill in the art reasonably have expected that antibody-containing serum from the blood of a domestic fowl immunized

with human hair would be a useful component in human hair care products? The record does not provide us with a "clear-cut" answer. We find that the evidence of record indicates that the antibodies in blood serum derived from fowl immunized with human hair as an antigen "are distinct" from the antibodies in blood serum derived from mammals immunized with human hair as

an antigen, especially in their antigen-binding properties. See pages 2 to 4, paragraphs 9 to 14, of Nojiri's Declaration Under 37 CFR 1.132. Nevertheless, Widder expressly states that antibody-containing serum derived from the blood of "[a]ny animal which is capable of forming antibodies in the blood" (Widder, col. 2, l. 8-9) in response to human hair would be useful in hair care products. We find that Widder's disclosure reasonably would have led persons having ordinary skill in the art to try antibody-containing serum derived from a domestic fowl immunized using human hair as an antigen to determine if its antigen-binding capacity was sufficient for use in human hair care products. However, "obvious to try" is not the standard for unpatentability under section 103. In re O'Farrell, 853 F. 2d 894, 903, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988).

Moreover, we find no suggestion in the cited prior art to use yolk antibody derived from domestic fowl immunized with hair antigen rather than antibody-containing serum derived from domestic fowl immunized with hair antigen in human hair care products. That "[a]ntibodies are readily transmitted to the yolk while still in the ovary, and in the fluid phase of

the yolk are found at levels equal to that in hen serum" (Tizard, p. 168, second full para.) is not sufficient basis for a holding that the subject matter appellants claim is unpatentable under 35 U.S.C. § 103. It is not enough for the art to recognize that passively acquired antibodies allow newly hatched chicks to resist vaccination in the same way that young mammals do (Id.). Fowl and mammal antibodies are distinct, and the examiner has not explained why a person having ordinary skill in the art would have sought to use yolk antibodies obtained from the eggs of domestic fowl immunized using human hair as an antigen in hair care products when the art expressly teaches persons having ordinary skill in the art to use antibody-containing serum obtained from the blood of animals immunized using human hair as an antigen in hair care products.

The holding of prima facie unpatentability under section 103 stands or falls in this case with the examiner's finding that "[t]he motivation lies in selecting an alternative source for the antibody which does not involve the removal of blood from the animal and the inconveniences associated therewith" (Examiner's Answer, p. 4, first para.). The examiner's

finding of motivation is clearly erroneous for two reasons. First, the evidence of record establishes that persons having ordinary skill in the art would not have looked to the egg yolk of domestic hens for "an alternative source" for the mammalian antibody utilized in the prior art because the serum antibodies derived from Widder's mammalian blood immunized using human hair as an antigen are distinct from yolk antibodies derived from an egg of a domestic fowl immunized using human hair as an antigen. Second, the cited prior art does not recognize any inconvenience associated with the removal of blood from chickens immunized with human hair as an antigen.

> There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure.

In re Dow Chem. Co., at 473, 5 USPQ2d at 1532. For the reasons stated, we reverse the examiner's rejection. "Both the suggestion and the expectation of success must be founded in the prior art disclosure, not in the applicant's disclosure." Id. at 473, 5 USPQ2d at 1531.

Conclusion

We reverse the examiner's rejection of Claims 1-3 and 5-18 under 35 U.S.C. § 103 as being unpatentable in view of the combined teachings of Widder and Tizard.

REVERSED

Sherman D. Winters Administrative Patent Judge	)	
William F. Smith Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Teddy S. Gron Administrative Patent Judge	)	

tdc

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